

Applicants respectfully select species 1C, on which claims 1 and 4 read, 2E, on which claims 1, 10, and 11 read, and 3B, on which claims 15 and 17 read. Applicants traverse the species election requirement in that, by having to elect only one of species 3(A-H), they have not been provided the opportunity to prosecute a species claim that reads on each of generic claims 15 and 21. See Office Action, p. 4.

Applicants further traverse the election requirement on the grounds that a reasonable number of species for each generic claim are pending in the application, which are written in dependent form and include all the limitations of the generic claim from which they depend. Thus, no prohibitive searching would be required to prosecute the species claims at this time.

In view of the above remarks, it is thus respectfully requested that the election requirement be withdrawn and that all claims be allowed to be prosecuted in the same application. In the event that the election requirement is made final, and in order to comply with 37 C.F.R. 1.143, Applicants reaffirm the previous provisional election of claims 1, 4, 10, 11, 15, 17 and 21 (generic claims and species 1C, 2E, subspecies of claim 11, and species 3B), holding claims 2-3, 6-9, 12, 16, 18-19, 22-24 and 27-28 (species 1A, 1B, 2A-D, 3A, 3C-D, and 3F-H and subspecies of claim 12) in abeyance under the provisions of 37 C.F.R. 1.142(b) until final disposition of the elected claims. Further, since claim 13 was not included in the election requirement, Applicants consider claim 13 under active consideration.

II. The References Cited in the Information Disclosure Statement Were Filed On August 8, 2001

In response to the note that references U20-U140, P1 and P2, which were listed on Form PTO-1449 originally filed on January 23, 2001, were not received by the examiner, Applicants respectfully submit that these references were resubmitted on August 8, 2001 after Applicants'

representative became aware from speaking with the Examiner on July 21, 2001 that these references had not been received. Applicants respectfully request that these references be considered at this time.

— No copies accompanied the Re-exam of the 1449.

III. 35 U.S.C. § 102 Rejection

Claims 1, 7, 10-13, 15-16, 19, 21-22, and 28 have been rejected for allegedly being anticipated by Riach *et. al.*, U.S. Patent No. 5,751,842 (herein "Riach") under 35 U.S.C. § 102(b). Applicants respectfully submit that, according to established principles of anticipation under 35 U.S.C. § 102(b), Riach does not anticipate the invention of claims 1, 7, 10-13, 15-16, 19, 21-22, and 28, either as originally written or as amended. For a § 102 rejection, "the reference must teach every aspect of the claimed invention either explicitly or impliedly . . . Any feature not directly taught must be inherently present." MPEP § 706.02. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Claims 15 and 21 are for processes, and "[a]nticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied expressly or inherently in a single reference." *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Here, Applicants respectfully submit that Riach does not teach, either explicitly, impliedly or inherently, the system or methods of claims 1, 15 and 21. For example, Riach does not teach a bank or automated banking system capable of processing a check remotely deposited by a customer at a terminal selectively locatable by the customer. Specifically, Riach does not disclose the features of: (1) an automated banking system and a check clearing system

Added
by amendment

configured to effectuate deposit of the discrete value of a check into an account of a customer payee, as set forth in claim 1; (2) a method for allowing a bank customer to deposit paper checks from a remote location where an automated banking system processes the discrete value of each check for deposit, as set forth in claim 15; (3) a method for allowing a bank to process a transaction for deposit of a conventional check payable to a bank customer, as set forth in claim 21; or (4) a terminal selectively locatable by a customer, as set forth in claims 1, 15 and 21, as amended. Further, Applicants submit there is no identity of the methods of claims 15 and 21 as originally written or as amended, and the process disclosed in Riach. *

It is stated in the Office Action that, "Riach et al. disclose a check depositing system and method comprising a remote processing terminal . . . connected to data processing circuitry suitable for electronic funds transfer whereby the customer's bank account can be automatically credited with the monetary value of a conventional check . . . [t]he customer logs on to the automated banking system using a bankcard and pin number and is authorized to continue . . . [t]he customer enters information from the check into the customer terminal using the keyboard . . . [a] funds transfer operation is effected wherein the value of the check is transferred from the payer's account to the payee's account . . . this process including the check clearing process." See Office Action, p. 5. It is further stated in the Office Action that Riach discloses a keyboard, digital image lift device, printer for issuing receipts, check endorsement by printing to prevent redeposit, vault for physical capture of the check, and electronic funds transfer. *Id.* at 5-6.

First, Applicants submit that the limitations set forth in claim 1 of an automated banking system and a check clearing system configured to effectuate deposit of the discrete value of a check into an account of a customer payee are not taught by Riach. According to the Office

Action, the rejection is based on the Riach disclosure found at col. 2, lines 18-28, col. 4, lines 30-47 and claim 1. *See* Office Action, p. 5. However, Applicants respectfully submit that these cited sections do not explicitly, impliedly, or inherently disclose or claim an automatic banking system interfaced and configured with a check clearing system to effectuate deposit of the discrete value of a check into an account of customer payee. The debiting or crediting of Riach's customer account is processed by Riach's apparatus, not an automated banking system. *See, e.g.*, claim 1 (An . . . ATM . . . comprising . . . a processing unit for . . . (ii) causing funds equal to the entire amount of the check to be transferred out of the account of the payer of the check and deposited into the account of the bank customer . . ."); Fig. 6, block 254 as explained at col. 4, lines 3-5 (Fig. 6 depicts a flowchart "illustrating the deposit function operation of the terminal 10") and lines 39-45 (Fig. 6 depicts in block 254 a funds transfer operation wherein the value of the check is transferred from the payer's account into the payee's account). Further, Riach discloses only an EFT, and not a check clearing system. In contrast, the system of claim 1 entails communication links between and configuration of a remote customer terminal with an automated banking system and a check clearing system, where deposit of the discrete value of a check is performed by the bank of first deposit, or BOFD. *See* Application, p. 3, lines 17-20 and 24-25; p. 4, lines 7-11; p. 8, lines 5-7; p. 9, line 8 through p. 10, line 5; claims 1, 15, and 21.

Further, Riach's apparatus is expressly denoted to be an ATM machine. *See* claim 1. ATM machines are not selectively locatable by a bank customer, as required in claim 1, as amended, and therefore the system of claim 1 is not anticipated by the disclosure of Riach.

Riach discloses the use of a keyboard for data entry for verification of the amount of a check, a digital image lift device to create a digital image for purposes of document

identification, and a printer for issuing receipts and for endorsing a check to prevent redeposit, as claimed in claims 7 and 10-13. However, claims 7 and 10-13 are dependent from claim 1, and since Riach does not anticipate claim 1 for the reasons given above, Applicants submit that Riach cannot anticipate any claims dependent from claim 1.

Claim 15 is a process claim with limitations that also are not taught explicitly, impliedly or inherently in the cited reference. Specifically, Applicants submit that Riach does not show each and every detail of the method of claim 15 including processing the discrete value of a check for deposit by an automated banking system, where the automated banking system comprises a bank and a geographically remote, selectively locatable customer terminal. As discussed with regard to claim 1, Riach discloses that the processing unit for causing funds to be transferred is a part of the claimed apparatus, which is distinct from the method of the invention. See Riach, claim 1; col. 2, lines 24-25. Applicants submit that the reference does not teach every aspect of the claimed invention either explicitly, impliedly or inherently, and the identical invention is not shown in Riach in as complete detail as is contained in claim 15.

In addition, as for claim 1, Riach's apparatus is expressly denoted to be an ATM machine. See claim 1. ATM machines are not selectively locatable by a bank customer, as required in claim 15, as amended, and therefore the method of claim 15 is not anticipated by the disclosure of Riach.

Further, there is no identity of the method disclosed in Riach and the method of claim 15. Specifically, the invention of claim 15, as originally written or as amended, does not require the transport of a document through the system for processing and for physical capture after processing. Riach's apparatus includes a transport mechanism, as found in ATM machines, to

move a document through the apparatus, and to feed the document into a pocket in order to physically capture the document after processing. *See* col. 2, lines 35-50; col. 4, lines 46-47; claim 1. There is no transport mechanism required to practice the method of claim 15. Since there is no identity of the method disclosed in Riach and the method of claim 15, the invention is not anticipated by Riach.

N.E. Claim 19 is dependent from claim 15, and since Riach does not anticipate claim 15 for the reasons given above, Applicants submit that Riach cannot anticipate any claims dependent from claim 15.

Similarly for claim 21, Riach does not disclose or claim the limitation of a bank processing a transaction for the discrete value of a check of a bank customer. In contrast, Riach discloses and claims that the processing unit for causing funds to be transferred is a part of the apparatus itself. As is true for claim 15, there is no identity of invention between the method of claim 21 and the Riach method, where the Riach method relies on a document transport mechanism to move the document for processing and for physical capture of the document after processing. The invention of claim 21 does not require the transport of a document through the system for processing and for physical capture after processing. In addition, the Riach apparatus is not selectively-locatable, as required by claim 21, as amended. Since there is no identity of the method disclosed in Riach and the method of claim 21, the invention is not anticipated by Riach.

N.E. Claims 22 and 28 are dependent from claim 21, and since Riach does not anticipate claim 21 for the reasons given above, Applicants submit that Riach cannot anticipate any claims dependent from claim 21.

Applicants respectfully request that the 35 U.S.C. § 102 rejections of independent claims 1, 15, and 21 be withdrawn, since the cited reference Riach does not disclose each and every aspect of the claimed invention in detail and since there is no identity of invention. Since the remaining claims 7, 10-13, 16, 19, 22, and 28 depend from one of claims 1, 15, or 21, Applicants respectfully request that the rejection of each of these claims under § 102 for anticipation likewise be withdrawn.

IV. 35 U.S.C. § 103 Rejections

Claims 2-4, 6, 8, 9, 17, 18, 23, 24 and 27 have been rejected as allegedly being unpatentable over Riach pursuant to 35 U.S.C. § 103(a). As is stated in the Office Action, “Riach . . . disclose a check depositing system and method as described above . . . However, the Riach . . . disclosure does not specifically mention the limitations of claims 2-6, 8, 9, 17, 18, 23, 24 and 27 . . . The examiner takes official notice that the limitations of claims 2-6, 8, 9, 17, 18, 23, 24 and 27 include only that, which was notoriously well known by those of ordinary skill in the electronic banking art at the time that the invention was made . . . It would therefore have been obvious to one of ordinary skill in the art at the time that the invention was made, to include any or all of the limitations of claims 2-6, 8, 9, 17, 18, 23, 24 and 27 in the Riach . . . check depositing system and method, as in doing so, one of ordinary skill would simply be availing of notoriously well known features and method steps in the field of electronic banking.” See Office Action, pp. 6-7.

As an initial matter, Applicants respectfully request that, pursuant to MPEP § 2144.03, the Examiner provide evidence supporting the official notice taken with regard to this rejection.

Applicants respectfully submit that the invention of claims 2-4, 6, 8, 9, 17, 18, 23, 24 and 27, as originally written or as amended, is not obvious because (1) the reference does not teach or suggest all the claim limitations in each instance and/or (2) there is no suggestion or motivation to modify the reference or to combine reference teachings and/or (3) a combination of the references does not result in the invention.

A. Riach does not teach or suggest all the claim limitations

Applicants respectfully submit that Riach does not render claims 2-4, 6, 8, 9, 17, 18, 23, 24 and 27 obvious because Riach does not teach or suggest all the claim limitations of independent claims 1, 15 and 21 from which these claims depend. For example, the claim limitations of (1) an automated banking system interfaced and configured with a check clearing system to effectuate the deposit of the discrete value of a check of a customer payee, as set forth in claim 1; (2) the processing of the discrete value of a check for deposit by an automated banking system, as set forth in claim 15; (3) the processing of a transaction by a bank for the discrete value of each check, as set forth in claim 21; and (4) a remote customer terminal selectively locatable by a customer, as set forth in claims 1, 15 and 21, as amended, are not disclosed in Riach.

The process disclosed in Riach teaches away from the processing of a deposited check by a BOFD, as it expressly claims that the processing unit that causes funds to be transferred out of the payer's account and into the customer's account is part of the apparatus. See Riach, claim 1. In contrast, in the system and methods of the invention, the BOFD effectuates the deposit of the discrete value of the deposited check. See Application, claims 1, 15, 21; Riach, claim 1. In addition, Riach's apparatus is an ATM machine which is not selectively locatable by a customer.

Thus, since Riach does not teach or suggest each and all the claim limitations of claims 1, 15 and 21, a *prima facie* case of obviousness has not been made in the Office Action for claims dependent from claims 1, 15 and 21, namely claims 2-4, 6, 8, 9, 17, 18, 23, 24 and 27.

Applicants thus respectfully request that this rejection be withdrawn.

B. There is no motivation to combine the references, and combination of the references does not result in the invention

This rejection is a § 103 combination rejection as it is stated in the Office Action that “[i]t would therefore have been obvious to one of ordinary skill in the art at the time that the invention was made, to include any or all of the limitations of claims 2-4, 6, 8, 9, 17, 18, 23, 24 and 27 in the Riach . . . check depositing system and method, as in doing so, one of ordinary skill would simply be availing of notoriously well known features and method steps in the field of electronic banking.” See Office Action, pp. 6-7. A proper § 103 combination rejection requires more than just finding in the references (here, Riach plus Official Notice by the examiner) the elements recited in the claim. To reach a proper teaching of a process through a combination of references, there must be stated in the reference(s) (or shown in the knowledge generally available in the art) an objective motivation to combine the teachings of references.

It is indicated in the Office Action that the limitations of the rejected claims were notoriously well known by those of ordinary skill in the electronic banking art at the time that the invention was made, and that therefore it would have been obvious to include any or all of the limitations of these rejected claims in the Riach system and methods. However, the Office Action does not establish an objective basis for combining the teachings of the references.

Further, Applicants submit that even the combination of the cited references would not result in any claimed invention depending from independent claims 1, 15 and 21.

In Riach's disclosed system and method, the claimed apparatus is an ATM comprising a transport for accepting the check, a printer for printing an image of the check onto a receipt, and a processing unit for processing the digitized images and causing funds to be transferred out of the account of the payer and into the account of the bank customer.

With respect to claim 1, even if the apparatus (the ATM) of Riach were substituted with a telephone (claim 2), a facsimile machine (claim 3) or a personal computer (claim 4) as suggested in the Office Action, the Riach apparatus and system is distinct from the invention of claim 1 because Riach does not disclose or teach an automated banking system configured with a check clearing system to effectuate the deposit of the discrete value of a check into the account of a customer payee. Riach's apparatus has been specially designed to operate in an ATM machine and includes a processing unit that causes funds equal to the entire amount of a check to be transferred out of the account of the payor and deposited into the account of the customer, whereas in the invention the automated banking system and check clearing system, *not* the customer terminal, are configured to effectuate deposit of the value of the check. Further, none of a telephone, a facsimile machine, or a personal computer include a transport mechanism for moving a document through the apparatus for processing and leading to the physical capture of the document after processing, as found in Riach's claimed and disclosed apparatus.

Likewise, the substitution of a keypad (claim 6), a microphone (claim 8), or a magnetic ink character reader (claim 9) for data entry in the Riach system would not result in the invention. The main purpose of Riach is to provide a printed image of portions of the submitted

document to enhance a customer's confidence that the document processed by the apparatus was correctly identified. *See* Abstract; Fig. 7; col. 1, lines 53-57; col. 4, lines 54-57; col. 5, lines 35-36; and claim 1. The Riach apparatus accomplishes this purpose by transporting the document past an image lift device that creates digitized images of the document, and then identifying the document by comparing the digitized images to a library of document image files. *See* col. 2, line 66 through col. 3, line 27; col. 4, lines 3-47. The receipt of the actual document by the apparatus is thus critical to the Riach system. In fact, substitution of these different methods of data entry are taught away from in Riach because they would drastically alter the entire purpose of the Riach system in that the document itself would not be imaged, with the image printed on a receipt.

Similarly, for claim 15, substitution of the limitations of claims 17 or 18 into the Riach method would not result in the system of the claimed invention because the addition of providing a provisional credit to the bank customer's account or denial of deposit of the discrete value of a check to the Riach method does not recite the claimed method for processing the discrete value of a check for deposit by the automated banking system. Again, in Riach, a processing unit in the claimed apparatus causes the fund transfer, whereas the automated banking system of claim 15 processes the discrete value of each check for deposit.

For claim 21, substitution of electronic check presentment (claim 23), the printing of a reconstructed check and the physically routing of the reconstructed check to the paying bank for payment 9 (claim 24), and the printing of a reconstructed check from an image of the check being presented for deposit by the bank customer (claim 27) into the apparatus or system of Riach would also not result in the system of the claimed invention, again because such a system

does not recite a method whereby a bank processes a check deposit transaction, as required in claim 21.

In addition, for both claims 15 and 21, as amended, the noted substitutions would not result in the claimed methods because the Riach apparatus (an ATM) is not selectively locatable by the customer.

Isolated teachings from one reference should not be combined with those of a second reference because they may be useful elements for forming a rejection without any objective basis for doing so. In the Office Action, no factual basis is stated for combining the teachings of these two references. Further, even the combination of the cited references in this instance would not teach the invention. In the absence of a suggestion to modify Riach with the limitations of the rejected claims, a *prima facie* case of obviousness has not been factually supported in the Office Action. In addition, each and every claim limitation of independent claims 1, 15 and 21, either as originally written or as amended, from which the rejected claims depend, are not disclosed or suggested in the cited references. Withdrawal of this obviousness rejection is thus respectfully requested.

CONCLUSION

Applicants submit that the application is in condition for allowance and respectfully request a notice of allowance for all the pending claims. Applicants request that Deposit Account 50-0206 be debited for the \$400.00 fee for a two month extension of time, and the \$528.00 fee for the added claims. It is believed that no other fees are due. However, should any other fees be determined to be due, Applicants request that such fees be charged against Deposit Account 50-0206. Should the Examiner determine that any further action is necessary to place

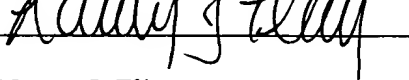


this application in condition for allowance, the Examiner is kindly requested and encouraged to telephone Applicants' undersigned representative at the number listed below.

Respectfully submitted,

HUNTON & WILLIAMS

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APPENDIX OF MARKED-UP VERSION OF AMENDED CLAIMS

1. (Twice amended) A system for depositing the value associated with conventional checks into the bank account of a customer payee comprising:

an interface to a customer terminal, the customer terminal being located
remotely from a bank, the customer terminal further being selectively locatable by
a customer payee;

an automated banking system connected to the customer terminal interface
via a communication link; and

an interface to a check clearing system, the check clearing system
connected to the automated banking system via a communication link;
wherein the automated banking system is configured such that information from a
conventional check is entered into the customer terminal, and
wherein the automated banking system and check clearing system are configured to
effectuate deposit of the discrete value of each check into an account of [a] the customer
payee.

15. (Twice amended) A method for allowing a bank customer to deposit the value of conventional checks into a bank account from a location that is remotely situated with respect to a bank, comprising:

(a.) receiving conventional checks payable to a bank customer payee;



(b.) logging the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank, wherein the customer terminal is selectively locatable by the bank customer payee;

(c.) entering transaction data into the customer terminal;

(d.) processing the discrete value of each check for deposit by the automated banking system; and

(e.) receiving a result of the transaction for each discrete check.

21. (Twice amended) A method for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location, comprising:

(a.) receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is selectively locatable by the bank customer;

(b.) authorizing [a] the bank customer [payee] as a user on the automated banking system;

(c.) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer; and

(d.) processing the transaction for the discrete value of each check.